

REMARKS

Claims 1, 2, 5-8, 23, 24, 33-35 have been amended to hyphenate "wound healing" as appropriate for referring to the polypeptide, the activity and the effective amount as suggested by the Examiner. Claim 1 has also been amended to correct the typographical error for "wound" as suggested by the Examiner. Claim 2 has also been amended to correct the typographical error "isoform" as suggested by the Examiner.

Claims 1 and 23 have been amended to insert a sequence identifier and to clarify that the composition comprises a wound-healing polypeptide that is selected from a specified Markush group.

Claims 9 and 20 have been amended to specify the correct sequence identifier for the peptide sequence for thymosin β 4.

Claim 40 has been amended to make it clear that it refers to any eye tissue as supported in the specification at page 8, line 23 and using language similar to that found in claim 133.

Claims 41-52 and 62-132 have been canceled as being directed to non-elected subject matter without prejudice to filing one or more division applications.

Claims 137-172 have been canceled in order to expedite the prosecution of the present application without prejudice to filing one or more continuation applications.

It is submitted that none of the above amendments constitute new matter, and their entry is requested.

The Examiner objected to claims 1, 2, 5-8, 11, 13, 23, 24, 33-36, 137 and 164 for various informalities. It is submitted that the amendments to the claims obviate this objection, and its withdrawal is requested.

The Examiner rejected claims 1, 2, 5-8, 11, 13, 16-19, 22-28, 33-36, 38-40, 53-61, 133-138, 141-144, 146, 147, 150-153, 155, 156, 159-162, 164, 165, 168-171 and 173-175 under 35 U.S.C. § 103(a) as being obvious over Malinda et al. (FASEB J 11(6):474-481, 1997) in view of Stevenson et al., (US 6,602,519 B1). It is submitted that the Examiner is in error in this rejection.

Specifically, Applicants submit that Stevenson et al. is not prior art under 35 U.S.C. § 102(e) and thus is not prior art for making the present rejection. Stevenson et al. issued from U.S. application Serial No. 09/647,117 that was filed as a 371 application of international patent application No. PCT/GB99/00833. This PCT application was filed on March 29, 1999. Thus, this PCT application was filed before November 29, 2000. According to section 13205 of Public Law 107-273, patents relating from an international application filed before November 29, 2000 shall not be effective as prior art as of the filing date of the international application. Thus, the effective prior art date for Stevenson et al. is January 23, 2001 as set forth on the face of Stevenson et al., i.e., the § 371 (c)(1), (2), (4) date. See, for example, M.P.E.P 706.02(f)(1), specifically I(C)(3), Example 6 and the first Flowchart.

The present application was filed on January 29, 2001 as a continuation of international patent application No. PCT/US99/17282 filed on July 29, 1999 which designated the U.S. This international application in turn is a nonprovisional application of U.S. provisional patent application Serial No. 60/094,690 filed on July 30, 1998. Thus, the present application claims priority under 35 U.S.C. § 120 to PCT/US99/17282 and under 35 U.S.C. § 119(e) to USSN 60/17282. Applicants note that this priority information was set forth in the Amendment and Response to Restriction Requirement filed on November 26, 2003. Accordingly, the present application claims priority to a date prior to the effective prior art date of Stevenson et al. Consequently, Stevenson et al. is not available as prior art against the present application, and thus, cannot be combined with Malinda et al. to render the claimed invention obvious.

In view of the above remarks, it is submitted that claims 1, 2, 5-8, 11, 13, 16-19, 22-28, 33-36, 38-40, 53-61, 133-136, as well as claims 9, 10, 12, 20, 21 and 37 are patentable over the cited prior art. As noted below, claims 137-172 have been canceled without prejudice to expedite the prosecution of this application. Withdrawal of this rejection is requested.

The Examiner rejected claims 137-144, 146-153, 155-162 and 164-171 under U.S.C. § 112, first paragraph for lack of enablement for the full scope of the claims. Although Applicants believe that these claims are fully enabled by the specification, they have nevertheless canceled claims 137-

172 in order to expedite the prosecution of this application and without prejudice to filing one or more continuation applications. Withdrawal of this rejection is requested.

The Examiner rejected claims 23-36, 38-40, 137, 138, 141-144, 150-153, 156 and 159-162 under U.S.C. § 112, second paragraph for being indefinite. Applicants submit that the amendment to claim 23 obviates this rejection with respect to claims 23-36, 38 and 39. Applicant submits that the phrase eye tissue in claim 40 is definite and means all eye tissue. The specification discloses that the tissue may be eye tissue (page 8, line 23), which is distinguished from corneal epithelial tissue that is used in the Examples and that is the subject matter of claim 56. Although Applicants believe that claim 40 as originally written was definite, they have nevertheless amended the claim using language similar to that found in claim 133 in an effort to make it more clear that any eye tissue is covered. Applicants submit that this amendment obviates the rejection with respect to claim 40. Applicants submit that the cancellation of claims 137-172 obviates this rejection with respect to claims 137, 138, 141-144, 150-153, 156 and 159-162. Accordingly, Applicants request the withdrawal of this rejection.

Applicants note that the Examiner indicated that claims 9-10, 12, 20-21 and 37 were withdrawn from consideration as being directed to non-elected subject matter. Applicants submit that claims 12 and 37 should not have been withdrawn from consideration. Claims 12 and 37 depend from claims 11 and 36, respectively, which were not withdrawn and are directed to the further use of an agent that promotes wound healing. Claims 12 and 37 set forth a Markush group for this agent. The Examiner never required restriction of these claims and never required an election of species of this agent. Thus, Applicants submit that claims 12 and 37 should be rejoined.

Claims 9 and 20 depend from claims 2 and 13, respectively, and are directed to the thymosin β 4 isoform. Claims 10 and 21 depend from claims 9 and 20, respectively, and are directed to a Markush group of thymosin β 4 isoforms. Because these claims are directed to additional species of the wound-healing polypeptide and are dependent from generic claims that Applicants submit are allowable, Applicants submit that claims 9, 10, 20 and 21 should be rejoined.

Application Serial No. 09/772,445
Amendment Dated 7 February 2006
Reply to Office Action of 24 August 2005

As described above, Applicants submit that the present application is a continuation of PCT/US99/17282 filed on July 29, 1999. In order to ensure that the present application obtains proper benefit of the prior filed applications, Applicants submit concurrently herewith a Petition Under 37 C.F.R. § 1.78 (a)(3) and an Application Data Sheet. As described above, the present application has previously been amended to refer to the priority applications.

Applicants are also submitting herewith an Information Disclosure Statement to bring additional references to the attention of the Examiner.

In view of the above amendments and remarks, it is submitted that the claims satisfy the requirements of the patent statutes and are patentable over the prior art. Reconsideration of the instant application and early notice of allowance are requested. The Examiner is invited to telephone the undersigned if it is deemed to expedite allowance of the application.

Respectfully submitted,

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